

### **REMARKS**

Claims 1-8 are pending in this application. Claims 1 and 4 are rejected. Claims 2, 3 and 5-8 are objected to.

#### **Claim Objections**

Claim 1 is objected to because of informalities. The Examiner indicates that a comparison of the amended version with the accompanying marked-up copy reveals that the graft monomer component and the lower limit of the reduced viscosity is missing from the claim. The Examiner refers to an apparent transcription error between the clean version of claim 1 in the Amendment of October 30, 2002, and the marked-up and clean versions in the Amendment of May 24, 2003. Applicants herein amend the claim to correct the wording.

Claim 7 is objected to because of informalities. The Examiner suggests that "C<sub>5</sub>" in claim 7 is a typographical error and should be "C<sub>6</sub>". Applicants herein cancel claim 7, thereby mooting the rejection.

#### **Rejections under 35 U.S.C. §112**

Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Applicants note that this is a new rejection in response to the amendment to claim 1 in the preliminary amendment of March 28, 2003. In that amendment, Applicants amended claim 1 to limit the 'polyfunctional monomer' to specific monomers in order to exclude the conjugated diene, namely to exclude graft copolymers derived from diene-containing backbone polymers."

In the rejection, the Examiner noted that, "Claim 4 indicates that organosilanes qualify as 'other monomers copolymerizable therewith (as *per* claim 1)." The Examiner here appears to be referring to the listing of cyclic siloxanes and alkoxysilanes in the same Markush group as alkyl acrylates, vinyl ether compounds, and other vinyl compounds. The Examiner states that "it is not understood how conventional cyclic siloxanes and alkoxysilanes, as exemplified in the claims and specification, are 'copolymerizable therewith.'" That is, the Examiner is noting that cyclic siloxanes and alkoxysilanes, as a class, do not have an ethylenic group for polymerization.

In response to the rejection, Applicants amend claims 1 and 4 to remove reference to organosiloxanes. Further, claim 4 is amended to remove reference to cyclic siloxanes and alkoxysilanes. Applicants submit that this amendment removes the basis for the above rejection.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner refers to the recitation of "alkyl acrylates other than those having a C<sub>2</sub> to C<sub>8</sub> alkyl group, acrylic esters. That is, the Examiner considers "acrylic esters" to be the same as "alkyl acrylates." Moreover, the recited "acrylic esters" are not limited in the length of the alcohol portion.

In response to the rejection, Applicants herein amend claim 4 to delete "acrylic esters" in the claim. Applicants submit that this amendment fully addresses the rejection.

Response under 37 C.F.R. §1.111  
Attorney Docket No. 001478  
Serial No. 09/700,171

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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